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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,230	09/28/2001	Charles W. Shattuck	091395-9194 (4132-TC-AU)	5871
23409	7590	09/22/2005	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			HANSEN, COLBY M	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,230

Applicant(s)

SHATTUCK ET AL.

Examiner

Colby Hansen

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12 and 21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6, 8-12 and 21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08242005.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bando (US Pat. 4,981,373).

Bando (US Pat. 4,981,373) discloses a thrust bearing with needle rollers 3, the thrust bearing comprising: a first race component 5 made of a first material and including a flat, circular raceway portion, defined about an axis, and an axially extending lip portion 7, 16; a plurality of needle rollers 3 arranged radially with respect to the axis for rolling contact with the flat raceway portion of the first race component; a bearing cage 4 retaining the needle rollers 3 and engageable with the lip portion of the first component for piloting of the bearing cage 4; and a second race component 13 made of a second material and including a flat portion in contact with the raceway portion of the first race component along substantially an entire portion of the race way portion supporting the plurality of needle rollers, and, also, including a lip portion 15, 17 extending axially and radially from the flat portion and beyond the lip portion of the first race component such that the second race component 13 is engageable by the bearing cage, as broadly recited, the second component is engageable to the bearing cage by way of the first component, to hold the first race component, the second race component and the bearing cage together as an assembly.

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Claims 1-2, 4, 6, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Polinsky et al. (US Pat. 5,529,400).

Polinsky et al. (US Pat. 5,529,400) discloses a thrust bearing with needle rollers 34, the thrust bearing comprising: a first race component 22 made of a first material and including a flat, circular raceway portion, defined about an axis, and an axially extending lip portion (fig. 4); a plurality of needle rollers 34 arranged radially with respect to the axis for rolling contact with the flat raceway portion of the first race component; a bearing cage retaining the needle rollers 34 and engageable with the lip portion of the first component for piloting of the bearing cage; and a second race component 18 made of a second material and including a flat portion in contact with the raceway portion of the first race component along substantially an entire portion of the raceway portion supporting the plurality of needle rollers, and, also, including a lip portion 55 extending axially and radially from the flat portion and beyond the lip portion of the first race component such that the second race component 18 is engageable by the bearing cage, as broadly recited, the second component is engageable to the bearing cage by way of the first component, to hold the first race component, the second race component and the bearing cage together as an assembly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8-9, 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bando (US Pat. 4,981,373).

Bando (US Pat. 4,981,373) discloses the claimed invention except for the first and second race components being made of specific material having certain characteristic with respect to one another or the duplication of the fixturing upon both races of the bearing assembly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized high carbon, bearing quality steel for the first race component, and more ductile and easily welded low carbon steel for the second race component in a number of forms to create the cheapest, highest possible quality bearing, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the same race fixturing assembly upon both races of the thrust bearing so as to have consistency in the fixturing structures that will provide a robust and easy method of assembly, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Claims 3, 5, 8-9, 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polinsky et al. (US Pat. 5,529,400).

Polinsky et al. (US Pat. 5,529,400) discloses the claimed invention except for the first and second race components being made of specific material having certain characteristic with respect to one another or the duplication of the fixturing upon both races of the bearing assembly or the fixturing assembly located on the radial inner portion of the bearing.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized high carbon, bearing quality steel for the first race component, and more ductile and easily welded low carbon steel for the second race component in a number of forms to create the cheapest, highest possible quality bearing, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the same race fixturing assembly upon both races of the thrust bearing, wherein the fixturing assembly would be on the radially outer and inner portions of the bearing, so as to have consistency in the fixturing structures that will provide a robust and easy method of assembly, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Response to Arguments

Applicant's arguments with respect to claims 1-6, 8-12 and 21 have been considered but are moot in view of the new ground(s) of rejection.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(571) 273-8300**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MEP. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MEP. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on _____

(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MEP. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colby Hansen whose telephone number is (571) 272-7105. The examiner can normally be reached on Monday through Thursday and every other Friday from 7:30 PM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chuck Marmor, can be reached on (571) 272-7095. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Colby M. Hansen

Patent Examiner

 9/14/05


Thomas R. Harmon
Primary Examiner